

REMARKS

Responsive to the Examiner's Final Action dated May 10, 1988 (paragraphs 5-7), applicants have amended the claims to more clearly and distinctly define their invention. Applicants submit that these amendments add no new matter to the application and are supported by the specification (i.e. recitation of R¹ and R² may be found in the specification at pages 6-7). Applicants request that the proposed amendments be entered into the application.

In paragraphs 1-4 of the Action, the Examiner raises the issue of applicants' duty of candor and disclosure. The Examiner raised the issue specifically with regard to two French patents cited in the EPO Search Report provided to the Examiner by "LETTER" dated March 21, 1988. The paper requested official citation of the Report and the references cited therein. The first of the French references FR-A-2 331 343, corresponds to Cohen et al. (U.S. 4,104,397) which was cited by the Examiner previously. The second French reference FR-A-2 146 962, is provided herewith together with its British counterpart (Patent No. 1,301,254) and a supplemental Form PTO 1449. Applicants respectfully submit that they have fully met their duty of candor and disclosure.

The Examiner objects to the use of the term "pharmaceutical" in the claims as being "too vague and indefinite to constitute a utility within the meaning of 35 USC 101" (paragraphs 8-9). He further states that a definite use should be recited to overcome this objection. Applicants respectfully traverse.

As previously discussed in the Amendment dated March 21, 1988 at pages 22-23, the utility of a claimed compound need not be recited in the claims of the application. The Examiner has not rebutted this assertion either by citation of statutory authority or case law to the contrary. Applicants respectfully submit that an invention meets the utility requirement of 35 U.S.C. 101 when the application disclosing the invention asserts a utility that is definite and believable on its face (MPEP 608.01(p)(A) at page 600-34).

In this regard, the Amendment of March 21, 1988 described the definite uses which are disclosed in the application for the compositions of the present invention (paragraph bridging pages 22-23). Furthermore, as defined by the Webster's Ninth New Collegiate Dictionary (1986), a pharmaceutical is a "medicinal" drug, i.e., a drug "tending or used to cure disease". Thus by its very definition the term pharmaceutical discloses a utility sufficient to meet the requirements of 35 U.S.C. 101 absent a showing by the Examiner

FISHER et al -- Serial No. 06/853,404

to the contrary (eg. unbelievability to one skilled in the art). Applicants respectfully submit, therefore, that the Examiner's objection is improper and should be withdrawn.

In view of the above and the fact that the claims remaining in the application, namely, 1-11, 13-17 and 42-54, 57-77 and 84-101 are not subject to any rejections based on the prior art, applicants submit that the claims are in condition for allowance and should be passed to issue. Reconsideration of the claims is respectfully requested, and an early and favorable action is earnestly solicited.

Respectfully submitted,

CUSHMAN, DARBY & CUSHMAN

By 

Carl G. Love

Reg. No. 18,781

Tel.: 861-3518

CGL/AMW/tas

1615 L Street, N.W.
Eleventh Floor
Washington, DC 20036-5601
(202) 861-3000